

REMARKS

This communication responds to the Final Office Action dated December 28, 2007 (hereinafter referred to as “the Final Office Action”) and the Advisory Action dated March 21, 2008.

Claim 4 is amended, no claims are canceled, and no claims are added in this communication. As a result, claims 1-10, 12-28, and 30-35 are now pending in this application.

In the Advisory Action, the Office merely concludes that the Applicant’s arguments filed on February 27, 2008 in response to the Final Office Action are not persuasive, but does not make any comments on the Applicant’s arguments. Accordingly, the Applicant respectfully submits that the Office does not properly support its conclusion reached in the Advisory Action.

§112 Rejection of the Claims

Claim 4 was rejected in the Final Office Action under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. The Applicant has amended claim 4 by removing “the seventy software component”, and thus believes that this amendment overcomes the rejection of claim 4 under 35 U.S.C. § 112, second paragraph. It is respectfully requested that the rejection of claim 4 under 35 U.S.C. § 112, second paragraph, be reconsidered and withdrawn.

Claims 5-9 were rejected in the Final Office Action under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Because a *prima facie* case of lack of written description has not been made, and because the requisite information has indeed been disclosed in the Application as-filed, Applicant respectfully traverses this rejection for the reasons stated below.

To establish a *prima facie* case of lack of written description under § 112, each one of four elements must be demonstrated. Viz, (1) the application does not reasonably describe or convey the concepts (2) to one of ordinary skill in the art (3) at the time of filing the patent application (4) of the claimed invention. None of the elements has been shown by the Office.

A description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. See, e.g., *In re Marzocchi*, 439 F.2d 220, 224, 169 USPQ 367, 370 (CCPA 1971). The examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. The examiner has the initial burden of presenting by a preponderance of evidence why a person skilled in the art would not recognize in an applicant's disclosure a description of the invention defined by the claims. *Wertheim*, 541 F.2d at 263, 191 USPQ at 97.

In addition, it is noted that “An application need not contain a word-for-word description of the claimed invention to satisfy the written description requirement. ... All that is needed is that the application reasonably convey the claimed subject matter.” See Patent Prosecution: Practice and Procedure Before the U.S. Patent Office by Irah H. Donner, pg. 738, 2002.

Applicant respectfully submits that the subject matters claimed in claims 5-9 have been disclosed in Figures 3, 12, 13, 14 and 15, as well as the following paragraphs for example with emphasis added:

“[0007] Figure 3 is a block diagram of a system embodiment of the present invention as an alternate to that in Figure 2. In another embodiment, the computing system 300 comprises a web server 302, at least one browser 304, and a database management system 306. The at least one browser 304 is in communication with the web server 302. The database management system 306 is accessible to the web server 302. The presentation layer and the business logic layer operate on the web server 302 and the data layer operates on the database management system 306. In one embodiment, **the business logic layer includes rules about keeping IDS references belonging to different organizations separate. In this way, organizations do not share IDS references. No individual associated with one organization has access to the IDS references belonging to another organization.** In another embodiment, the business logic layer includes an accounting system for tallying the costs of retrieving and/or storing IDS references for each organization.”

“[0021] Figure 15 is a block diagram of a method embodiment of the present invention in addition to those in Figure 12, 13, and 14. **Figure 15 shows how a reference propagates to related matters when it is added to a matter. When a reference is added 1500 to matter A 1502, it is propagated to all matters related to matter A that also meet certain criteria. Criteria include whether the matter is a patent application, a reissue application, whether the matter is allowed, or pending, and the like**”

In addition, the following table, for example, illustrates specifically the support of the Specification to claims 5-9:

Claims 5-9	Specification
5. The system as recited in claim 1, wherein a first matter is related to a second matter within the organization by a criteria.	[0021] Figure 15 is a block diagram of a method embodiment of the present invention in addition to those in Figure 12, 13, and 14. Figure 15 shows how a reference propagates to related matters when it is added to a matter. When a reference is added 1500 to matter A 1502, it is propagated to all matters related to matter A that also meet certain criteria. Criteria include whether the matter is a patent application, a reissue application, whether the matter is allowed, or pending, and the like
6. The system as recited in claim 5, wherein the related matters are stored in a storage only accessible to the organization who owns the matters.	[0007] In one embodiment, the business logic layer includes rules about keeping IDS references belonging to different organizations separate. In this way, organizations do not share IDS references. No individual associated with one organization has access to the IDS references belonging to another organization. In another embodiment, the business logic layer includes an accounting system for tallying the costs of retrieving and/or storing IDS references for each organization.
7. The system as recited in claim 6, wherein all the matters within the organization are classified.	[0021] Figure 15 is a block diagram of a method embodiment of the present invention in addition to those in Figure 12, 13, and 14. Figure 15 shows how a reference propagates to related matters when it is added to a matter. When a reference is added 1500 to matter A 1502, it is propagated to all matters related to matter A that also meet certain criteria. Criteria include whether the matter is a patent application, a reissue application, whether the matter is allowed, or pending, and the like

8. The system as recited in claim 7, wherein all the matters within the organization are classified by status of a patent application, which is pending, issued, withdrawn, or abandoned.	[0021] Figure 15 is a block diagram of a method embodiment of the present invention in addition to those in Figure 12, 13, and 14. Figure 15 shows how a reference propagates to related matters when it is added to a matter. When a reference is added 1500 to matter A 1502, it is propagated to all matters related to matter A that also meet certain criteria. Criteria include whether the matter is a patent application, a reissue application, whether the matter is allowed, or pending, and the like
9. The system as recited in claim 7, wherein all the matters within the organization are classified by type of a patent application.	[0021] Figure 15 is a block diagram of a method embodiment of the present invention in addition to those in Figure 12, 13, and 14. Figure 15 shows how a reference propagates to related matters when it is added to a matter. When a reference is added 1500 to matter A 1502, it is propagated to all matters related to matter A that also meet certain criteria. Criteria include whether the matter is a patent application, a reissue application, whether the matter is allowed, or pending, and the like

In summary, the specification of the Application reasonably describe or convey the concepts to one of ordinary skill in the art at the time of filing the patent application of the invention claimed in claims 5-9. Therefore, since a *prima facie* case of lack of written description has not been made, and because the requisite information has indeed been disclosed in the Application as-filed, it is respectfully requested that the rejection of claims 5-9 under 35 USC § 112, first paragraph, be reconsidered and withdrawn.

§102 Rejection of the Claims

Claims 1-10, 12-28 and 31-35 were rejected in the Final Office Action under 35 U.S.C. § 102(e) for anticipation by Grainger et al. (U.S. Patent Application Publication No. 2002/0065677 A1, hereinafter “Grainger”). Applicant respectfully traverses the rejection of these claims under 35 U.S.C. § 102(e) for the reasons stated as follows.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Claim 1 recites as follows, with emphasis added:

1. A system for managing information disclosure statement (IDS) references, comprising:
a computing system;
a first software component operable on the computing system to generate a plurality of IDS forms;
a second software component operable on the computing system to manage IDS references for at least one organization; and
a task managing software component operable on the computing system to manage tasks within matters; and
a database comprising the IDS references,
wherein **each organization only has access to its own IDS references.**

In the claimed Application, as shown in Figure 6, for example, organizations A, B and C do not share IDS references, and **each organization (A, B and C) only has access to its own IDS references.**

In the “Response to Arguments” part, on page 11, the Final Office Action asserts, “*Grainger teaches a system with an electronic IDS/electronic document storage component (Para 0038)*” and “*Grainger discloses controlling user access rights to the IDS information (Para 0081, organizations maintain control of who access their IDS records through access code ...)*”, and concludes that Grainger discloses the feature “**each organization only has access to its own IDS references**” as recited in claim 1. Applicant disagrees with the conclusion for at least the reasons stated below.

First, Applicant submits that paragraph 0038 of Grainger, cited by the Final Office Action, does not disclose the feature “**each organization only has access to its own IDS references**” as recited in claim 1. Referring to Grainger, paragraph 0038, with emphasis added:

“[0038] Once a user has identified a relevant electronic document, embodiments of the present invention automatically extract relevant portions of the reference information from the electronic document into an electronic information disclosure statement (“electronic IDS”). The portion of the reference information relevant to an electronic IDS is referred to herein as IDS information. It is to be understood that the reference information in an electronic document may include some or all of the information necessary for including a particular prior art reference in an electronic IDS for disclosure to a patent office. IDS information as defined herein includes whatever portion of the reference information that is relevant to completing an invention disclosure to a patent office. **Moreover, an electronic IDS may be an electronic file for storing IDS information extracted from an electronic document. Additionally, an electronic IDS, as referred to herein, may also be a electronic file storing a plurality of pointers. Each pointer may correspond to a relevant local or remote electronic document containing IDS information that must be submitted to an official patent office.** Alternatively, in one embodiment, the electronic IDS is a electronic file for storing each relevant electronic document that must be submitted to an official patent office. In that case, the IDS information is filtered from the electronic IDS when the final Information Disclosure Statement is submitted. In yet another embodiment, the reference information or the entire electronic documents are stored in a database, and the electronic IDS is a file corresponding to a particular patent application that includes cross-references to particular documents stored in the database.”

Clearly, from the above excerpt quoted by the Final Office Action, it can be seen that Grainger fails to teach the feature “**each organization only has access to its own IDS references**” as recited in claim 1. Rather, due to the adoption of pointers, one electronic IDS of Grainger may share a relevant remote electronic document containing IDS information with another electronic IDS, and thus different organizations may possibly share the same relevant remote electronic document containing IDS information. This is distinguishable from the feature “**each organization only has access to its own IDS references**” as recited in claim 1

Secondly, Applicant submits that paragraph 0081 of Grainger, relied upon by the Final Office Action, does not disclose the feature “**each organization only has access to its own IDS references**” as recited in claim 1. Referring to Grainger, paragraphs 0081, with emphasis added:

“[0081] As mentioned earlier, one embodiment of IDS generation program 806 may include **program code for controlling the user access rights for each electronic IDS**. Such code may require the user to enter an access code or password before being allowed access to an existing electronic IDS. For example, the access to each electronic IDS may be limited to individuals falling under the duty of disclosure for the corresponding future or pending patent application. Therefore, an IDS generation program may prompt a user for an access code when a user requests access to an electronic IDS. If the user provides the correct code, then the IDS generation program may allow the user to access the electronic IDS. However, if the user provides an incorrect code, the IDS generation program may not allow the user to access the electronic IDS. This feature would be particularly useful for ensuring that only individuals associated with the filing and prosecution of a particular patent application will have the ability to update or modify an electronic IDS corresponding to a particular patent application.”

Clearly, from the above excerpt quoted by the Final Office Action, it can be seen that **Grainger restricts user access rights to the IDS information**, but does not disclose to restrict one organization from sharing IDS references with another organization. In other words, Grainger may restrict access to IDS references **on the user level**, while claim 1 is related to the restriction of access to IDS references **on the organization level**. They are thus obviously different. Thus, the Final Office Action fails to show that paragraph 0081 of Grainger discloses the claimed feature “**each organization only has access to its own IDS references**” in claim 1.

Accordingly, the above assertions of the Final Office Action and cited paragraph 0038 and paragraph 0081 of Grainger do not justify the conclusion reached by the Final Office Action that Grainger discloses the feature “**each organization only has access to its own IDS references**” as recited in claim 1.

In summary, for at least the above reasons, the Final Office Action fails to show that Grainger discloses the feature “**each organization only has access to its own IDS references**” as recited in independent claim 1, and thus fails to show that Grainger anticipates independent claim 1. The discussions presented above with respect to independent claim 1 also apply to independent claims 10, 13, 17 and 21. Thus, the Applicant respectfully submits that the Final Office Action also fails to show that Grainger anticipates these independent claims.

Dependent claims 2-9, 12, 14-16, 18-20, 22-28 and 31-35 respectively, directly or indirectly, depend on independent claims 1, 10, 13, 17 and 21. Thus, for at least the same

reasons discussed with respect to these independent claims, Applicant respectfully submits that the Final Office Action also fails to show that Grainger anticipates these dependent claims.

Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1-10, 12-28 and 31-35 under 35 U.S.C. § 102(e).

§103 Rejection of the Claims

Claim 30 was rejected in the Final Office Action under 35 U.S.C. § 103(a) as being unpatentable over Grainger in view of Official Notice. Applicant respectfully traverses the rejection of claim 30 under 35 U.S.C. § 103(a) for the reasons stated below.

The Applicant agrees with the admission by the Office that Grainger fails to teach “providing an accounting system to track costs associated with storing IDS references”, which is recited in claim 30.

Claim 30 depends on claim 21, accordingly includes the feature “**restricting access to IDS references so that each organization only has access to its own IDS references**” of claim 21. As discussed above with respect to claim 21, Grainger actually teach away from the feature “**restricting access to IDS references so that each organization only has access to its own IDS references**” as recited in claim 30. Two organizations of Grainger may possibly share the same IDS references due to the usage of pointers, because for example paragraph 0038 of Grainger shows that the electronic IDS referenced by one organization **may contain pointers** pointing to IDS references and the IDS references may also be referenced by another organization, in contrast to claim 30,. Thus, Applicant submits that Grainger does not disclose the feature “**restricting access to IDS references so that each organization only has access to its own IDS references**” as included in claim 30.

Thus, Grainger does not teach or suggest all the limitations which are recited in claim 30, and certainly does not suggest to combine reference teachings. Accordingly, Applicant submits that claim 30 is not rendered obvious over Grainger in view of Official Notice, and respectfully request that the rejection of claim 30 under 35 U.S.C. § 103(a) should be withdrawn.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 373-6976 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 24 day of April 2008.

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